REMARKS

Applicant has amended claim 1 to clarify that the film of the invention has a co-extruded AB or ABA structure. Since this structure was implicit in the claims as previously amended, this amendment does not raise new issues and should be entered.

As noted previously, the film of this invention is a co-extruded multi-layer film of an AB or ABA structure in which the A layer contains more talc than the B layer (which may or may not contain talc). The films of this invention, as explained in the specification of this application, provide unexpectedly good results because of their use of talc in the claimed amounts. With the entry of the amendments above, claims 1, 7-13, 17-29, 35-41 and 45-56 remain pending in this application.

Claims 1, 7-13, 17-29, 35-41 and 45-56 stand rejected under 35 USC 103(a) on Minami in view of Murschall '352 or Murschall '754. The Examiner relied primarily on Minami, referring to column 2, lines 14-24; column 4, lines 4-30; column 5, lines 10-35; column 7, line 60, to column 7, line 3; and column 7, lines 30-35. The Examiner read Minami as disclosing a polyester film comprising "a base polyester layer A and at least one matte polyester surface layer B, wherein the matte surface layer B contains 3-40 wt% inorganic particles (e.g. talc) having a typical diameter of 0.3-20 microns, wherein the surface layer B can be coextruded with the base layer or first extruded separately as a single layer film, wherein surface layer B is uniaxially or biaxially oriented. The base layer optionally contains additives such as pigments." The Examiner has relied on the Murschall references as evidence of the use of allegedly conventional additives such as UV absorbers and/or flame retardants in polyester films. This rejection is respectfully traversed.

As explained above, the Examiner relies upon Minami as disclosing a multiple layer polyester film including a co-extruded polyester resin and an A layer having a higher talc content than a B layer or layers. In the last response, applicants explained that that Minami does not does not disclose or suggest that that talc should be used as the inorganic particles as claimed.

In response, the Examiner admitted that Minami fails to disclose the use of talc as the inorganic particle component of the disclosed surface layer. The Examiner, however, asserted that the use of talc would be an obvious choice and that "Applicant has not provided probative evidence of unexpected results or criticality from the recited use of talc . . ."

Applicants have provided herewith the declaration of Tracy Paolilli. Ms. Paolilli's declaration shows that the use of talc as claimed markedly increases the haze and surface roughness of the films and markedly decreases the clarity of the films as compared to films that utilize inorganic silica particles. Further, the significant benefits achieved when talc is used as claimed in the claimed polyester films are not disclosed or suggested by any of the prior art references.

For the foregoing reasons, early action allowing claims 1, 7-13, 17-29, 35-41 and 45-56 is solicited.

In the event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 584642001200.

Dated: May 30, 2006

Respectfully submitted,

By

Jonathan Bockman
Registration No. 45,640

Morrison & Foerster LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7769
Facsimile: (703) 760-7777